

REMARKS**I. General**

Claims 1-20 were pending in the present application. Claims 1-4, 6-8, and 10-20 are rejected and claims 5 and 9 are objected to in the current Office Action dated January 30, 2004. The issues raised in the Office Action are:

- Claims 1-4, 7, 8, and 10-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,760,925 to Saund et al. (hereinafter "*Saund*") in view of U.S. Patent No. 4,513,319 to Breimer (hereinafter "*Breimer*").
- Claims 6 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Saund* in view of *Breimer* and in further view of the present application specification on page 3, lines 8-21.

Applicant traverses the outstanding issues and requests, in view of the amendments and remarks set forth below, that the Examiner pass the present application to allowance.

II. Amendments

In this response, Applicant amends claims 1, 3, 5, 7, 9, 13, and 15, cancels claims 2 and 12 without prejudice, and adds new claims 21-29.

More particularly, the current Office Action indicates that claims 5 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of their respective base claim and any intervening claims. As such, claims 5 and 9 are rewritten in independent form, and are thus believed to be in condition for allowance.

Independent claim 1 is amended herein to include the limitation of dependent claim 2. Thus, independent claim 1 is effectively amended to rewrite claim 2 in independent form. As such, amended claim 1 is to be interpreted with the full breadth of the original claim 2. In view of this amendment to claim 1, claim 2 is canceled without prejudice herein and claim 3 is amended to change its dependency from canceled claim 2 to claim 1.

Independent claim 7 is amended herein to include the limitation of dependent claim 12. Thus, independent claim 7 is effectively amended to rewrite claim 12 in independent form. As such, amended claim 7 is to be interpreted with the full breadth of the original claim 12. In view of this amendment to claim 7, claim 12 is canceled without prejudice herein and claim 13 is amended to change its dependency from canceled claim 12 to claim 7.

Independent claim 15 is amended herein to recite “wherein the calibrating means uses a calibration path that mimics an imaging path to be used by said look-down digital imaging device for imaging said target scan area.”

No new matter is added by the amendments and new claims presented herein.

III. Rejections under 35 U.S.C. § 103(a)—Combination of *Saund* and *Breimer*

Claims 1-4, 7, 8, and 10-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Saund* in view of *Breimer*. Applicant respectfully traverses this rejection as discussed further below.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. §2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the first or third criteria for establishing a prima facie case of obviousness.

A. Applied Combination Fails to Teach All Claim Elements

Independent claim 1, as amended herein, recites in part “focusing on a calibration area within said look-down digital imaging device”.

Independent claim 7, as amended herein, recites in part “calibration area arranged within said look-down digital imaging device ... wherein said look-down digital imaging device is operable to achieve an in-focus scan of said calibration area for calibration of said look-down digital imaging device” (emphasis added).

And, independent claim 15, as amended herein, recites in part “a look-down digital imaging device that includes ... means for calibrating said look-down digital imaging device, wherein the calibrating means uses a calibration path that mimics an imaging path to be used by said look-down digital imaging device for imaging said target scan area” (emphasis added).

To make a proper 35 U.S.C. § 103(a) rejection, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. The combination of *Saund* and *Breimer* does not teach or suggest the limitations recited above for independent claims 1, 7, and 15. As the current Office Action admits (on page 2 thereof), *Saund* fails to disclose a calibration area within its look-down imaging system. Instead, *Saund* teaches an external calibration system 14 on the surface of the platform 8. However, the current Office Action relies on *Breimer*'s teaching of a device that has an internal calibration area in asserting that it would have been obvious to combine such a device into *Saund*'s system.

Breimer teaches a method for automatically setting up a television camera in which an external test pattern is present on a test chart in front of the camera and an internal test pattern is present in the camera in the optical path between a camera lens system and a camera pickup arrangement. See Abstract of *Breimer*. More specifically, *Breimer* provides at column 1, line 52 – column 2, line 6:

According to the invention, a setup method which precedes the normal preparations for scene recording includes two separate steps in which an external and an internal test pattern are used separately. During the setup with the external test pattern, the external test pattern is present on a test chart in front of the camera. During the setup with the internal test pattern, the internal test pattern is present in the camera in the optical path between a lens system of the camera and the pickup arrangement. The separate setups with the external and internal test patterns are effected with a non-blocked optical path and a blocked optical path, respectively in which the lens system is incorporated.

... The correction information associated with the internal test pattern is subtracted from the correction information associated with the external test pattern, and the resulting correction difference information (which relates to at least the lens system) is stored in a lens memory. The camera memory and lens memory together produce the correction information for correction with minimal error.

Breimer fails to teach or suggest at least the above-identified elements of independent claims 1, 7, and 15. For instance, *Breimer* fails to teach or suggest using “an in-

focus scan of said calibration area for calibration”, as recited by independent claims 1 and 7. Rather, *Breimer* specifically teaches that the optical path between the lens system and the camera pickup arrangement is blocked when scanning its internal test pattern. Thus, *Breimer* does not teach an in-focus scan of such internal test pattern.

Further, *Breimer* fails to teach or suggest a calibrating means that “uses a calibration path that mimics an imaging path to be used ... for imaging said target scan area”, as recited by independent claim 15. The optical path used for scanning the internal test pattern in *Breimer* does not mimic an imaging path to be used for imaging a target scan area.

In view of the above, neither *Saund* nor *Breimer* teach or suggest the above-identified elements of independent claims 1, 7, and 15. As such, the applied combination of *Saund* and *Breimer* fails to teach at least the above-identified elements of independent claims 1, 7, and 15. Therefore, Applicant respectfully asserts that independent claims 1, 7, and 15, as amended herein, are patentable over the applied combination.

Further, dependent claims 2-4, 8, 10-14, and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Saund* in view of *Breimer*. Each of these dependent claims depend either directly or indirectly from one of independent claims 1, 7, and 15 and thereby inherit all of the limitations of their respective independent claims. Accordingly, without conceding that the Examiner’s assertions are valid with respect to the limitations of the rejected dependent claims, it is respectfully submitted that the dependent claims are allowable based on their dependency from their respective independent claims 1, 7, and 15 for the reasons discussed above. Thus, Applicant respectfully submits that dependent claims 2-4, 8, 10-14, and 16-19 are patentable under 35 U.S.C. §103(a).

B. Lack of Motivation to Combine References

To make a proper 35 U.S.C. § 103(a) rejection there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify a reference or to combine reference teachings, and it is the Examiner’s initial burden to provide some suggestion or motivation. See M.P.E.P § 2142. The current Office Action fails to identify proper suggestion or motivation to combine *Saund* and *Breimer*. The current Office Action asserts on pages 2-3 the following:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Breimer's device with that of Saund et al., because, the combination would form a look down imaging apparatus with calibration area within the device in the proper position.

This line of logic does not identify proper motivation for combining *Saund* and *Breimer*. Rather, this is simply a statement that it would be obvious to combine the references because such a combination can be made. It is well settled that the fact that references can be combined is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Further, the language of the recited motivation is circular in nature, stating that it is obvious to make the combination because it is obvious to achieve the result. In other words, the recited motivation states that it is obvious to combine the internal calibration area of *Breimer* with the look down imaging apparatus of *Saund* because such a combination would result in a look down imaging apparatus with the internal calibration area. Such a statement can always be made for any combination (i.e., it is obvious to combine the references because it would result in the combination). However, this fails to identify any motivation (or desire) that would lead one of ordinary skill in the art to make such a combination.

The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01. Thus, the current Office Action fails to identify proper motivation for making the applied combination, as the motivation must establish the desirability for making the combination. Rather, it appears that the motivation is provided by the disclosure of the present application. The motivation must be provided by the prior art, not by Applicant's disclosure. Relying on Applicant's disclosure for piecing together the combination is impermissible hindsight. M.P.E.P. § 2143.01.

IV. Rejections under 35 U.S.C. § 103(a)—Combination of *Saund*, *Breimer*, and the present application's specification

Claims 6 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable *Saund* in view of *Breimer* and in further view of the present application's specification at page 3, lines 8-21. Claims 6 and 20 depend directly or indirectly from their respective independent claims 1 and 15 and thereby inherit all of the limitations of their respective base claims. Accordingly, without conceding that the current Office Action's assertions are valid

with respect to the limitations of the rejected dependent claims, it is respectfully submitted that the dependent claims are allowable based on their dependency from independent claims 1 and 15 for the reasons discussed above. Thus, Applicant respectfully submits that based on at least the arguments above, claims 6 and 20 are patentable under 35 U.S.C. §103(a).

V. Newly Added Claims 21-29

New claims 21-29 are added herein, and are believed to be allowable over the art of record as discussed further below. Newly added claims 21-25 each depend either directly or indirectly from one of independent claims 1 and 7, and thereby inherit all of the limitations of their respective independent claims. Accordingly, it is respectfully submitted that these dependent claims are allowable at least based on their dependency from their respective independent claims 1 and 7 for the reasons discussed above.

Further, newly added independent claims 26 and 28 each recites limitations that are not taught or suggested by the combination of *Saund* and *Breimer*. Accordingly, these newly added independent claims are believed to be of patentable merit over the art of record. Also, newly added claims 27 and 29 each depend either directly or indirectly from one of independent claims 26 and 28, and thereby inherit all of the limitations of their respective independent claims. Accordingly, it is respectfully submitted that these dependent claims are allowable at least based on their dependency from their respective independent claims 26 and 28.

VI. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

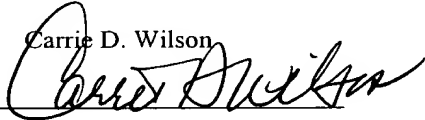
If any additional fee is due, please charge Deposit Account No. 08-2025, under Order No. 10001227-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 255078570US in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: April 14, 2004

Typed Name: Carrie D. Wilson

Signature: _____



Respectfully submitted,

By: _____



Jody C. Bishop
Attorney/Agent for Applicant(s)
Reg. No. 44,034
Date: April 14, 2004
Telephone No. (214) 855-8007